

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

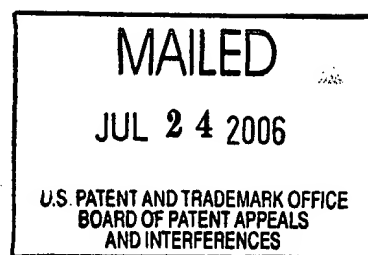
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MELVIN HATCH

Appeal No. 2005-0941
Application 09/941,029

ON BRIEF



Before FRANKFORT, BAHR and FETTING, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request for rehearing of the decision mailed February 23, 2006, wherein a merits panel of the Board affirmed the examiner's various rejections of claims 1 through 4, 6, 7 and 9 through 18. The rejections of claim 5 under 35 U.S.C. § 103(a) were not sustained. Appellant now seeks rehearing only as to the affirmance of the obviousness rejections of dependent claims 9 and 10, more specifically, of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Golden in view of Emmer, of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Golden in view of Margulies, of claim 9 under 35 U.S.C. § 103(a) as being unpatentable

over Golden in view of Spremulli and Emmer, and of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Golden in view of Spremulli and Margulies. The thrust of appellant's arguments in the request is that Spremulli, Emmer and Margulies are from non-analogous arts and thus would not reasonably have been consulted by a person of ordinary skill in the art in addressing the particular problem confronted by appellant.

We have carefully considered each of the points of argument raised by appellant in the request for rehearing, however, those arguments do not persuade us that the prior merits panel overlooked or misapprehended any points raised in the appeal, or that the determinations on the patentability of claims 9 and 10 were in error.

In considering the question of non-analogous prior art for resolution of obviousness under 35 U.S.C. 103, the law presumes full knowledge by the hypothetical worker having ordinary skill in the art of all the prior art in the inventor's field of endeavor. With regard to prior art outside the inventor's field of endeavor, knowledge is presumed only as to those arts reasonably pertinent to the particular problem with which the inventor was involved. See In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), In re Wood, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979) and In re Antle, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971). Thus, as the prior merits panel

noted on page 9 of the decision, the determination that a reference is from a non-analogous art is twofold. First, it must be decided if the reference is from within the inventor's field of endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was concerned.

In the present case, the prior panel determined that Spremulli, Emmer and Margulies were each within appellant's field of endeavor, which the specification of the present application (page 1) indicates "relates to a heat-conducting support." The prior panel specifically found that each of the above-noted patents related to a support formed of metal, thereby inherently having the capability of conducting heat, even if such a characteristic was not specifically disclosed therein, thus making the supports in the three patents at issue heat-conducting supports. We see no reason to alter or overturn those determinations.

Appellant's arguments in the request for rehearing do not appear to specifically challenge the prior panel's determination that Spremulli, Emmer and Margulies are within appellant's field of endeavor. Instead, the arguments appear to urge only that one of ordinary skill in the art, seeking to solve appellant's problem of providing good support for a vessel as well as good heat transfer thereto, would not reasonably be expected or motivated to look to

the garbage can of Spremulli, the coffee bottle support plate of Emmer, or the paper sundae dish holder of Margulies. Thus, it appears that appellant's arguments are directed to the second aspect of the above-noted test for non-analogous art, i.e., whether a reference is reasonably pertinent to the particular problem with which the inventor was concerned.

However, we note that the twofold test defined above is fully satisfied by the prior panel's determination that each of the three applied patents in question are within appellant's field of endeavor. Thus, in this case, no inquiry into whether the references are reasonably pertinent to the particular problem with which the inventor was concerned is required to resolve the issue of non-analogous art. On that basis alone, appellant's arguments in the request for rehearing are unpersuasive. Moreover, we simply do not agree with appellant's basic contention that just because a support is made of metal (and hence would conduct heat) does not make it a heat-conducting support. Just as the prior panel has found, we find that a support made of metal is inherently a heat-conducting support.

Thus, on the basis of the foregoing, we conclude that Spremulli, Emmer and Margulies are analogous prior art and that they were properly considered by the examiner in the obviousness rejections of claims 9 and 10 on appeal. As a further point, we note

that it is well settled that in cases involving relatively simple every-day mechanical concepts, like those involved in the present application, it is reasonable to permit inquiry into other areas where one of even limited technical skill would have been aware that similar problems exist. See In re Heldt, 433 F.2d 808, 167 USPQ 676, 679 (CCPA 1970). We also note that, contrary to appellant's view, Emmer specifically addresses appellant's basic problem noted in the request for rehearing, i.e., that of providing good support for a vessel as well as good heat transfer thereto. See, e.g., page 1, column 1, lines 21-36, of Emmer.

Accordingly, appellant's request is granted to the extent of reconsidering the decision mailed February 23, 2006, but is denied with respect to making any changes therein.

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No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

DENIED

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)

Jennifer D. Bahr

JENNIFER D. BAHR)
Administrative Patent Judge)

Anton W. Fetting

ANTON W. FETTING)
Administrative Patent Judge)

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) APPEALS
) AND
) INTERFERENCES

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